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APPLICATION NO.	TION NO. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO			
09/545,962	04/10/2000		Наггу Мајог	555255012125	3247			
7	590	11/27/2001						
David B Coch				EXAMINER				
Jones Day Rea North Point		e		EDELMAN, E	RADLEY E			
901 Lakeside A Cleveland, OH				ART UNIT	PAPER NUMBER			
,				2153				

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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•		Application No.	Applicant(s)									
	•	09/545,962	MAJOR ET AL.									
-	Office Action Summary	Examiner	Art Unit									
	•	Bradley Edelman	2153									
	The MAILING DATE of this communication appears on the cover sheet with the correspondence address											
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THE N - Exten after: - If the - If NO - Failur - Any re	DRTENED STATUTORY PERIOD FOR REPLY MAILING DATE OF THIS COMMUNICATION. sions of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. period for reply specified above is less than thirty (30) days, a reply period for reply is specified above, the maximum statutory period we to reply within the set or extended period for reply will, by statute, the provision of the Office later than three months after the mailing dipatent term adjustment. See 37 CFR 1.704(b).	86(a). In no event, however, may a reply be tir within the statutory minimum of thirty (30) day rill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	nely filed  s will be considered timely. the mailing date of this communication. (D) (35 U.S.C. § 133).									
1)[	Responsive to communication(s) filed on <u>24 August 2001</u> .											
2a)⊠	This action is <b>FINAL</b> . 2b) Thi	is action is non-final.										
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.											
Dispositi	on of Claims											
4)🖾	Claim(s) 23-29 is/are pending in the applicatio	n.										
4	4a) Of the above claim(s) is/are withdrawn from consideration.											
5)□	5) Claim(s) is/are allowed.											
6)⊠	Claim(s) <u>23-29</u> is/are rejected.											
7)	Claim(s) is/are objected to.	·	•									
8)□	Claim(s) are subject to restriction and/or	election requirement.	•									
Application	on Papers											
9)[] 1	he specification is objected to by the Examiner	:										
10)∐ T	he drawing(s) filed on is/are: a) accep	·	•									
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	nder 35 U.S.C. §§ 119 and 120	211 III I CI .	\$ <sub>6</sub> .									
	Acknowledgment is made of a claim for foreign	priority under 25 LLS C \$ 110/a										
	All b) Some * c) None of:	priority under 33 0.3.C. § 119(a	)-(u) or (i).									
ے ر	1. Certified copies of the priority documents	have heen received										
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	<ul> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>											
14)∏ A	knowledgment is made of a claim for domestic	priority under 35 U.S.C. § 119(	e) (to a provisional application).									
	☐ The translation of the foreign language proventions. The translation of the foreign language proventions.											
Attachment(	s)											
2) 🔲 Notice	of References Cited (PTO-892) of Draftsperson's Patent Drawing Review (PTO-948) ation Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Informal I	r (PTO-413) Paper No(s) Patent Application (PTO-152)									
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#### **DETAILED ACTION**

This action is in response to Applicant's amendment and request for reconsideration filed on August 24, 2001. Claims 23-29 are presented for further examination. Claims 23-29 are new claims.

#### Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially" in claim 26 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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2. Claims 23, 24, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz et al. (U.S. Patent No. 5,995,597, hereinafter "Woltz"), in view of Minata (U.S. Patent No. 6,157,318) and Deo et al. (U.S. Patent No. 5,973,612, hereinafter "Deo").

In considering claim 23, Applicant's claims contain three primary features:

- a. Replicating and redirecting data items received at a host system from a plurality of remote systems, via e-mail, to a mobile data communication device.
- b. "Characterizing" the data items at the host system according to data item type and data item priority.
- c. Applying a notification scheme at the mobile communication device, wherein a type of notification alert for receipt of a data item at the mobile device may depend on a person associated with the data item, the data item type, and/or the data item priority.

These features are all well known in the art.

In considering (a), Woltz teaches a host system (host computer 34) that redirects data items received from a plurality of remote systems (i.e. different e-mail addresses), to a mobile data communication device (pagers 28, 30). See col. 3, lines 18-46. The host first stores the messages (col. 3, line 33), and then replicates and redirects the messages via e-mail to the mobile device (col. 4, lines 14-26).

In considering (b),

system according to data item type (i.e. received e-mail, Financial News notice, sports scores, schedule reminder message; col. 5, line 58 – col. 6, line 20), appriority (col. 2, lines 34-35; can be processed at the host). It is well

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to a mobile device, e.g. see Kuki, EP Pat. No. 772,327 A2, col. 5, lines 25-28; col. 7, lines 10-20; see also Eggleston et al. (U.S. Patent No. 6,101,531), col. 8).

used by the mobile pager device. Nonetheless, the application of separate notification schemes at a mobile communication device, according to information relating to a message being received, is well known, as evidenced by both Minata and Deo.

In a similar art, Minata discloses a paging system, wherein both a priority of messages received at a mobile pager device (col. 2, lines 63-64; col. 3, lines 32-40), and a person associated with the messages received at the device (col. 4, lines 30-38), can determine what type of notification will be used at the device. Additionally, in the same field of art, Deo discloses a paging system, where the data item type of messages (col. 8, lines 1-2) can determine what type of notification will be used at the device. Therefore, given the teaching of Minata and Deo, it is clear that controlling message notification type at a mobile device according to a message data type, a message priority, or a person associated with a message, are all well known. Furthermore, it would have been obvious to a person having ordinary skill in the art to include any or all of these schemes in the pager disclosed by Woltz, so that the user can be notified immediately of whichever specific messages the user believes are the most important (see Deo, col. 2, lines 7-19; see Minata, col. 1, lines 61-63).

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In considering claim 24, Deo further discloses the possibility that messages sent from remote systems and routed to the mobile device may have one set of priority characterizations, while the mobile device itself may have a separate set of priority characterizations for the same messages. Deo then describes an elaborate scheme for resolving how to select which priorities take precedence (see col. 10, line 50 – col. 14, line 13). Thus, given the teaching of Deo, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using the scheme taught by Deo to resolve any priority disputes between messages received and processed at the host system, and messages received and processed at the Mobile device in the system taught by the Woltz, Minata, and Deo, in order to provide considerable latitude in controlling the notification provided to the user when a page object is received (see Deo, col. 14, lines 6-10). Therefore, it would have been obvious to use the priority resolving method taught by Deo to resolve inconsistent prioritizations between the host and the mobile device in the system taught by Woltz, Minata, and Deo.

In considering claim 27, Woltz further discloses that the data item types include e-mail messages received from the remote systems (col. 3, lines 23-24), and further wherein the e-mail messages are characterized as either inbound e-mail data item types (i.e. archived messages – col. 3, line 33) or outbound e-mail data item types (col. 3, lines 37-40).

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In considering claim 28, the combined system taught by Woltz, Minata, and Deo does not disclose the sending of transmission status data items, or characterizing the disclosed e-mail messages as these types. Nonetheless, Woltz discloses that the emails can be any type of e-mail (see Abstract), and transmission status e-mails (such as confirmation or receipt) e-mails are well known. Examiner takes official notice that it is further well known for notification of transmission status messages, such as confirmation of delivery and confirmation of receipt messages, to appear as a different icon on standard e-mail programs (such as Microsoft Outlook). Therefore, given the combined teaching of Woltz, Minata, and Deo, a person having ordinary skill in the art would have readily recognized the desirability and advantages of allowing transmission status messages received at the mobile device to notify the user with a unique notification criteria, so the user can avoid unnecessary fumbling with the device or unnecessary searching through her purse in order to look at the device's visual display. Therefore, it would have been obvious to further characterize messages in the system taught by Woltz, Minata, and Deo as transmission status messages.

3. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz, in view of Minata and Deo, and further in view of Tuoriniemi et al. (U.S. Patent No. 5,978,689, hereinafter "Tuoriniemi").

In considering claim 25, although the system taught by Woltz, Minata, and Deo teaches substantial features of the claimed invention, it fails to disclose providing an earpiece with a speaker, and providing an alert type including a spoken name of a

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person associated with the data item. Nonetheless, such an alert scheme is well known, as evidenced by Tuoriniemi. In a similar art, Tuoriniemi discloses a personal portable communication device including a earpiece with a speaker, and which can receive pager messages, telephone calls, and e-mails (Fig. 1; col. 2, lines 35-39), and wherein the user can be notified of incoming messages according to a spoken name of a person sending the message (col. 11, lines 61-67). Therefore, given the teaching of Tuoriniemi, it would have been obvious to a person having ordinary skill in the art to include the spoken name notification alarm disclosed by Tuoriniemi in the pager message forwarding system taught by Woltz, Minata, and Deo, so that the pager user can be immediately aware of who is sending a message (see col. 11, lines 58-60).

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz, in view of Minata and Deo, and further in view of Croft et al. (U.S. Patent No. 6,078,826, hereinafter "Croft").

In considering claim 26, neither Woltz, Minata, nor Deo discuss power-saving capabilities of the pager system. Nonetheless, allowing pagers or other mobile devices to receive calls while otherwise remaining in a low power state is well known, as evidenced by Croft. In a similar art, Croft discloses a mobile device which remains in a low power state, where the device can receive messages but is otherwise substantially disabled (Abstract). When a call is received, the device will return to a normal power state. Given the teaching of Croft, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using the power saving functions

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of the mobile device taught by Croft with the prioritized messaging scheme taught by the combined teaching of Woltz, Minata, and Deo, in order to save battery power in the pager device at all times except true, urgent emergencies (see Woltz, col. 2, lines 34-35). Therefore, it would have been obvious to include the power saving functions of the system taught by Croft in the combined pager messages receiving system taught by Woltz, Minata, and Deo.

5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman (U.S. Patent No. 6,034,621), in view of Deo.

In considering claim 29, Kaufman discloses a method of redirecting e-mail messages and meeting notices from a host system to a mobile data communication device via a wireless network, comprising the steps of:

receiving e-mail messages and meeting notices from a plurality of remote systems at the host system (col. 1, lines 48-62; col. 3, lines 1-5; wherein such messages are inherently sent from a plurality of remote systems, and both e-mails and meeting notices can be sent via Microsoft's Schedule+ or Outlook program); and

generating a plurality of electronic envelopes at the host system, wherein the electronic envelopes include the received e-mail messages or meeting notices, redirecting the envelopes from the host system to the mobile device via a wireless network, and receiving the envelopes at the mobile device (envelopes are inherent in the forwarding of messages from the host to the mobile device – see col. 3, lines 1-5; col. 4, lines 30-44).

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Furthermore, Outlook, which is included in the system taught by Kaufman, inherently includes a priority field and message type field for its messages.

However, Kaufman does not explicitly disclose the claimed characterization steps, wherein the envelopes containing the messages are characterized at the host system according to the data type or priority, the data type or priority is extracted at the mobile device in order to effect the alert type according to a specific notification scheme, and the data type or priority can be user-defined. Nonetheless, such a characterization system is well known, as evidenced by Deo. In a similar art, Deo discloses a system that also utilizes Microsoft's Schedule+ and Outlook programs, for forwarding messages from a host to a mobile device, wherein different messages can be characterized according to a user preference, and wherein those characterizations will effect the alarm type at the mobile device according to a specific notification scheme (col. 7, lines 19-21, 55-58; col. 8, lines 1-2, 16-26). Given the teaching of Deo, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using different notification schemes for the different types or priorities of messages taught by Kaufman, so that a user who has lost his reading glasses would not have to strain his eyes to look at the small screen of the mobile device. Therefore, it would have been obvious to include different notification schemes, as taught by Deo, for the messaging system taught by Kaufman.

#### Response to Arguments

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Applicant's arguments with respect to claims 23-29 have been considered but are most in view of the new ground(s) of rejection.

#### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-

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3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.

BE

November 13, 2001

GLENTON B. BURGESS

SUPERVISORY PATENT EXAMINER TECHNOLOGY CENTER 2100



### Notice of References Cited

Application/Control No.

09/545,962

Examiner

Bradley Edelman

Applicant(s)/Patent Under Reexamination MAJOR ET AL.

Art Unit

2153

Page 1 of 1

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	В	US-5978689	11-1999	Tuoriniemi et al.	455	569	
	С	US-6157318	12-2000	Minata	340	7.58	
	D	US-6178331	01-2001	Holmes et al.	455	466	
	Ε	US-5815081	09-1998	Motohashi	340	7.58	
	F	US-6311282	10-2001	Nelson et al.	713	324	
	G	US-6078826	06-2000	Croft et al.	455	574	
	Н	US-5969636	10-1999	Parvulescu et al.	340	7.53	
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#### **NON-PATENT DOCUMENTS**

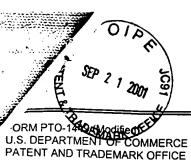
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\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)

Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



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# INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use several sheets if necessary)

Atty Docket No.: 555255012125

Application No.: 09/545,962

Applicant:: Major et al.

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Technology Center 2100

RM PTO-1449 (Modified) S. DEPARTMENT OF COMMERCE

Atty Docket No.: 555255012125

Application No.: 09/545,962

ATENT AND TRADEMARK OFFICE INFORMATION DISCLOSURE Applicant:: Major et al. STATEMENT BY APPLICANT (Use several sheets if necessary) Filed: April 10, 2000 Group: 2153 37 CFR 1.98(b)) **U.S. PATENT DOCUMENTS** Exam. Patent Number Issue Date Patentee Class Subclass Filing Date Init. BE 5 9 7 3 8 10/26/1999 Chase, Jr. 38 9 2 4 07/18/2000 Shaffer et al. FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION **Publication** Translation Date of the **Document Number** Grant Country or Patent Office Class Subclass Yes No OTHER DOCUMENTS (Including Author, Title, Date\*\*, Relevant pages, Place of Publication\*\*\*) adley Edelman Date Considered 11/13/01

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FORM PTO-1449 (Modified) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

(37 CFR 1.98(b))

# INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use several sheets if necessary)

Atty Docket No.: 555255012125

Application No.: 09/545,962 AUG 2 7 2001

Applicant:: Major et al. Technology Center 2100

Filed: April 10, 2000

Group: 2153

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Atty Docket No.: 555255012125

Application No.: 09/545,962

Applicant:: Godfrey et al.

Filed: August 28, 2000 Technology Center 2100 (37 CFR 1.98(b)) Group: 2153 **U.S. PATENT DOCUMENTS** Exam. Init. Patent Number Issue Date Subclass Patentee Class Filing Date BE 6 3 5 0 06/10/1997 Robson 5 8 4 9 4 6 9 12/01/1998 Goldman et al. 5 9 0 5 7 7 7 05/18/1999 Foladare et al. 5 9 7 4 8 0 10/26/1999 Schwendeman 5 9 8 3 0 7 3 11/09/1999 Ditzik 6 6 3 2 7 4 12/19/2000 Lindgren FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION Publication Translation Exam. Date of the Init. **Document Number** Grant Country or Patent Office Class Subclass Yes No OTHER DOCUMENTS (Including Author, Title, Date\*\*, Relevant pages, Place of Publication\*\*\*) BE

Buddley Edelman Examiner

Date Considered 11/13/01

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Atty Docket No.: 555255012125
Application No.: 09/545,962

Applicant:: Major et al.

Filed: April 10, 2000

Group: 2153

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